



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/667,036

09/22/2003

Jeyhan Karaoguz

14967US02

7866

23446 7590 07/11/2011
MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER

HAMILTON, LALITA M

ART UNIT

PAPER NUMBER

3691

NOTIFICATION DATE

DELIVERY MODE

07/11/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mhmpto@mcandrews-ip.com

1 UNITED STATES PATENT AND TRADEMARK OFFICE

2
3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7
8 *Ex parte* JEYHAN KARAOGUZ
9 and JAMES D. BENNETT
10

11
12 Appeal 2010-004430
13 Application 10/667,036
14 Technology Center 3600
15

16
17 Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
18 ANTON W. FETTING, *Administrative Patent Judges*.
19 FETTING, *Administrative Patent Judge*.

20 DECISION ON REQUEST FOR REHEARING
21
22

1 STATEMENT OF CASE

2 This is a decision on rehearing in Appeal No. 2010-004430. We have
3 jurisdiction under 35 U.S.C. § 6(b).

4 Requests for Rehearing are limited to matters misapprehended or overlooked
5 by the Board in rendering the original decision. 37 C.F.R. § 41.52.

6 ISSUES ON REHEARING

7 Appellants raise 3 issues in the Request for Rehearing. The first issue relates
8 to whether the panel misapprehended whether the art describes the limitation of
9 “allowing at least one user to create at least one user defined media channel” in
10 claim 40.¹

11
¹ Claim 40 reads as follows:

40. A system comprising:
a user interface for the selection and display of media content, the user interface
allowing at least one user to create at least one user defined media channel,
wherein the at least one user selects media content for the at least one user defined
media channel through the user interface, and the at least one user specifies,
through the user interface, times when the user selected media content will be
made available via the at least one user defined media channel, the user interface
displaying a graphical representation of the at least one user defined media channel
comprising a sequence of the user selected media content for consumption at the
times specified by the at least one user.

1 The second issue relates to whether the panel misapprehended whether the art
2 describes three locations as in claim 46.²

3 The third issue relates to whether the panel concluded improperly whether
4 patentable weight is to be afforded the limitation of the request comprising
5 information securing payment for delivery in claim 46.

6 The Appellants also request that we clarify what appears to be a typographic
7 inconsistency between the Conclusions of Law and Decision sections of the
8 Decision.

9 ANALYSIS

10 We found in our decision that the rejection of claims 40-53 under 35 U.S.C. §
11 103(a) as unpatentable over Schein and Future TV is proper. (Decision 7).

12 *First Issue*

13 The Appellants argue that the panel misapprehended that there is no enabling
14 disclosure in Schein or Future TV that expressly or necessarily describes a user-
15 defined media channel. (Request 3). We find this unpersuasive.

16 As the panel found at Decision 6, claim 40, the broadest claim, is to a system,
17 and so steps doing anything with a user defined media channel would be irrelevant.

² Claim 46 reads as follows:

46. A system comprising:

at least one server at a first location, the at least one server configured to store media content; and server software that receives via a communication network a request for the delivery of the media content from the at least one server at the first location, the request comprising information securing payment for delivery, and that responds by coordinating the delivery of the media content from the at least one server at the first location to a storage at a second location to a television display at a third location for consumption.

1 Instead, the structure must simply be capable of performing what claim 40 recites.
2 Claim 40 allows a user to create such a user defined media channel and displays a
3 graphical representation of a user defined media channel. Schein allows a user to
4 enter information and displays information that would be useful in creating such a
5 user defined media channel.

6 Accordingly, the panel found that claim 40 is broad enough to encompass
7 Schein's permitting and displaying the data called for in claim 40, even though
8 Schein does not explicitly create such a user defined media channel. The panel
9 was unpersuaded by the Appellants' argument that Future TV is a non-enabling
10 reference since Future TV explicitly states that the technology it describes was
11 already in the possession of those of ordinary skill.

12 Again, it was sufficient that such technology inherently provide the capacity
13 for allowing, i.e. permitting, a user to create a user defined media channel. The
14 claim does not specify that such creation occurs on the recited system, but only that
15 such creation be permitted.

16 As Schein described a user interface that permitted a user to specify media
17 content and times, and Future TV provided at least the suggestion of user specified
18 media, the combination of the references were found to at least permit user
19 creation of such media content, should a user so desire. Since the claim does not
20 recite the actual creation of such content, enablement of such creation is not at
21 issue.

22 *Second Issue*

23 The Appellants contend that the panel misapprehended the requirement for 3
24 locations in claim 46. Request 6. We find this unpersuasive. The panel found
25 Schein receives requests for a guide at a server, from which the guide is

downloaded to a local computer for display on a screen or TV. Decision 6. Thus, Schein describes 3 separate physical entities, viz. server, computer, and TV, each of which occupies a location separate from the others. The claim does not specify any minimum distance separating the locations.

Third Issue

The Appellants finally contend that the panel should have afforded patentable weight to the limitation of the request comprising information securing payment for delivery in claim 46. The Appellants cite various MPEP sections and related cases concerning the use of functional limitations in support of this contention. Presumably, the Appellants contend the panel misapprehended the law pertaining to the contents of data entered into an apparatus that is defined by a claim.

It appears that the Appellants have instead misapprehended the panel's findings and are conflating functional limitations with apparatus contents limitations. Claim 46 is an apparatus claim. As such, the contents of data that is entered, not being a structural element of the apparatus, does not itself serve to define the apparatus. "[E]xpressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim." *Ex parte Thibault*, 164 USPQ 666, 667 (BPAI 1969). Furthermore, "inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Otto*, 312 F.2d 937, 940 (CCPA 1963).

CONCLUSION

Nothing in Appellants' request has convinced us that we have overlooked or misapprehended the art or claims as argued by Appellants. Accordingly, we DENY the request that we reverse the rejection of claims 40-53.

1 We clarify, as the Appellants' request, that the rejection affirmed pertains to
2 claims 40-53, and not to claims 1-53.

3 DECISION

4 To summarize, our decision is as follows:

- 5 • We have considered the REQUEST FOR REHEARING.
- 6 • We DENY the request that we reverse the Examiner as to claims 40-53
- 7 • We GRANT the request that we clarify our original decision
 - 8 ○ The rejection of claims 1-39 under 35 U.S.C. § 103(a) as unpatentable
 - 9 over Schein and Future TV is not sustained.
 - 10 ○ The rejection of claims 40-53 under 35 U.S.C. § 103(a) as
 - 11 unpatentable over Schein and Future TV is sustained.

12
13
14 REHEARING GRANTED-IN-PART

15
16 erc